

REMARKS

Claims 1-11 remain pending, although claims 3-11 are withdrawn from consideration. Claim 2 is amended, and claims 12-17 are added. No claims are canceled.

The disclosure is objected to because of informalities, and the Office Action provides reasons on pages 2-3. As shown above, applicants amend the disclosure in a fashion consistent with the comments in the Office Action. Accordingly, applicants now request the withdrawal of the objection to the disclosure.

Claim 2 is objected to because of informalities.

Applicants respectfully disagree that “an eyepiece” in line 4 should be changed to –the eyepiece–. Applicants acknowledge that parent claim 1 recites “an eyepiece part.” However, the two recitations of “an eyepiece” in line 4¹ are part of the recitation “an eyepiece part *side*,” and the term “eyepiece part side” was not recited before line 4. An “eyepiece part” and an “eyepiece part side” are not the same, so “the” is not necessary in front of “an eyepiece” in line 4. Accordingly, changing “an eyepiece” in line 4 to –the eyepiece– is unnecessary.

Regarding the comments with respect to lines 6-7, applicants amend claim 2 accordingly.

Withdrawal of the objection to claim 2 is now requested.

Claim 1 is rejected under 35 U.S.C. § 103(a) as obvious over Kleinschmidt et al., U.S. Patent No. 6,085,112, in view of Spitzer, U.S. Patent No. 6,349,001. Applicants respectfully traverse this rejection as improper.

Claim 1 describes a mobile phone having a “video camera part,” and the claim specifies that the video camera part is “mounted to the phone body.” The rejection relies on the Kleinschmidt et al. communication device K disclosed in Fig. 5 to teach a mobile phone. Regarding the video camera part (not disclosed in Fig. 5), Fig. 6 is cited in the Office Action.

¹ The Office Action does not indicate which of the two recitations on that line is the one that should be changed.

Specifically, camera CAM in Fig. 6 is relied upon to teach the video camera part recited in claim 1.

However, as discussed above, claim 1 explicitly states that the video camera part is “mounted to the phone body.” Although the Office Action states that Fig. 6 teaches this feature (see page 4, bottom), this interpretation of Kleinschmidt et al. is not proper. Figs. 1-5 show a mobile phone, but Fig. 6 only shows block diagrams of circuitry. Out of Figs. 1-5, only Fig. 2 shows camera CAM, and it does *not* show camera CAM “mounted to the phone body” as claimed. Instead, camera CAM is part of a separate module. (Column 5, lines ~9-10.) The Kleinschmidt et al. text corresponding to Fig. 6 references the “component which can be removed separately as module” (column 6, lines 57-59) and then discusses camera CAM (column 6, line 67).

Based on the paragraph as a whole, which includes this cited text, and the figures and text cited above, applicants respectfully submit that Kleinschmidt et al. strongly implies to one skilled in the art that the only circuitry represented in Fig. 6 as “mounted to the phone body” is the circuitry shown inside the dot-dash box on the left side of the drawing. One skilled in the art should view Kleinschmidt et al. as disclosing a camera that is *not* mounted to the phone body in any of its embodiments.

For at least this reason, the rejection is not proper and should be withdrawn. Nonetheless, there is another reason to withdraw the rejection:

Even if Kleinschmidt et al. really did teach a video camera part mounted to a phone body, to justify a rejection, the prior art would still need to teach or suggest that the video camera part is mounted “so that a direction of the eye of the user and a direction for taking an image are parallel or approximately parallel when the arm is opened” as recited in claim 1.

It is acknowledged in the Office Action that Kleinschmidt et al. does not teach this feature. The rejection relies instead on Spitzer to suggest modifying the Kleinschmidt et al. mobile phone to have the quoted feature. However, Spitzer does not provide such a suggestion, as explained in the following:

Applicants of course acknowledge that Spitzer discloses in Fig. 2 camera 210 oriented so that a direction for taking an image and a direction of the eye of the user are parallel or approximately parallel. *However, this configuration is part of an eyeglass interface system that is specifically designed for concealing a camera.* (See, for example, column 4, lines 46-47.) Such concealment was not a goal of the Kleinschmidt et al. communication device. The Kleinschmidt et al. device would still be observable to people near the user, even if camera CAM were mounted on the body of communication device K. Applicants find no teaching or suggestion in Kleinschmidt et al. of a communication device designed to remain concealed while in use.

Applicants acknowledge that, *if* the Kleinschmidt et al. camera CAM were to be mounted to the body of communication device K, it *might* be obvious to orient the direction for taking an image and the direction of the eye of the user to be approximately parallel. However, the Office Action does not sufficiently show that camera CAM is mounted to communication device K (and Fig. 2 teaches the opposite), and Spitzer only shows the parallel camera and eye directions in a system designed for concealment, which has not been shown to be a goal of Kleinschmidt et al. Thus, it has not been shown that Spitzer can suggest modifying the Kleinschmidt et al. communication device to have every feature recited in claim 1.

Therefore, for also a second reason, applicants request the withdrawal of the obviousness rejection of claim 1.

Claims 3-11 were not examined in the recent Office Action, because they were not elected for further prosecution after the Examiner's requirement for an election of species on May 12, 2005. However, claims 3-8 depend from claim 1. Thus, applicants request that claims 3-8 be rejoined with the elected claims as depending from an allowable base claim. Because claim 1 should be deemed allowable, claims 3-8 should also be deemed allowable for at least the reason of their dependency.

The Office Action indicates on page 5 that claim 2 would be allowable if rewritten into independent form and to overcome an indefiniteness rejection under 35 U.S.C. § 112, second paragraph.² As shown and discussed above, claim 2 is amended appropriately. Accordingly, allowance of claim 2 is now requested.

Via the present submission, applicants add new claims 12-17. These claims are substantial duplicates of claims 3-8, but they depend from claim 2 instead of from claim 1. Because claim 2 should be deemed allowable as discussed above, claims 12-17 should also be deemed allowable for at least the reason of their dependency.

In view of the remarks above, Applicants submit that the entire application is in condition for allowance, and a Notice of Allowability is now requested. The Examiner is welcome to contact the undersigned if any issues remain unresolved.

² Although page 3 of the Office Action indicates that claim 2 was objected to because of form instead of rejected as indefinite, the intended meaning is clear.

If necessary, the undersigned authorizes deducting any fees that may be due from Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Joseph L. Felber
Attorney for Applicants
Registration No. 48,109
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

1250 Connecticut Avenue,
NW – Suite 700
Washington DC, 20036-2657

Enclosure: Petition for Extension of Time

JLF/af
Q:\2001\011500\011500 response to 6-30-05 action.doc